

REMARKS

This is a full and timely response to the outstanding nonfinal Office Action mailed March 13, 2003. Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested.

1. Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-7, 9-19, and 21-24 remain pending in the present application. Claims 5 and 24 have been amended to clarify the meanings of the claims, and the amendments do not add new matter to the present application.

2. Response to Rejection of Claim 24 under 35 U.S.C. 112, Second Paragraph

Claim 24 has been rejected under 35 U.S.C. 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 has been amended to obviate the rejection. Accordingly, Applicants respectfully submit that claim 24 is in compliance with 35 U.S.C. Section 112, Second Paragraph, and is in condition for allowance.

Applicants wish to clarify that the foregoing amendment has been made for purposes of better defining the invention in response to the rejections made under 35 U.S.C. § 112, and not in response to the rejections made based on a prior art reference. Indeed, Applicant submits that no substantive limitations have been added to the claims. Applicant further submits that this amendment is non-narrowing and, pursuant to *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831 (2002), no prosecution history estoppel arises from this amendment. *See also Black & Decker, Inc. v. Hoover Serv. Ctr.*, 886 F.2d 1285, 1294 n. 13 (Fed. Cir. 1989); *Andrew Corp. v. Gabriel Elecs., Inc.*, 847 F.2d 819 (Fed. Cir. 1988); *Hi-Life Prods. Inc. v. Am. Nat'l. Water-*

Mattress Corp., 842 F.2d 323, 325 (Fed. Cir. 1988); *Mannesmann Demag Corp. v. Eng'd. Metal Prods. Co., Inc.*, 793 F.2d 1279, 1284-1285 (Fed. Cir. 1986); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

3. Response to Rejection of Claims 1-3, 6, 9, 10, 11, 13, 17, 18, 21, 22 and 23 under 35 U.S.C. § 103(a)

Claims 1-3, 6, 9, 10, 11, 13, 17, 18, 21, 22, and 23 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Qureshey* (WO 99/38266). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon prior art, the prior art must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claim 1

As provided in independent claim 1, Applicant claims:

1. A method for receiving digital information and transmitting the information in a localized area, comprising the steps of:
receiving an audio communication as digital information from a remote source via the Internet;
converting the digital information to analog information;
broadcasting the analog information at low power in a localized area in at least one preselected radio frequency chosen by a user; and
receiving the broadcast information in the localized area on a radio frequency receiver tuned to at least one frequency to permit listening to the audio communication.

(*Emphasis added*).

Applicant asserts that the rejection should be withdrawn because *Qureshey* fails to disclose or otherwise teach the step that is highlighted above. Specifically, *Qureshey* fails to disclose,

suggest, or teach “broadcasting . . . in at least one preselected radio frequency chosen by a user,” as recited in claim 1. *Qureshey* appears to disclose an approach of providing a transmitted signal to a receiver using radio communication. However, *Qureshey* does not disclose, suggest, or teach the feature of the transmission occurring on a “preselected radio frequency chosen by a user.” Further, *Qureshey* does not provide the proper motivation to make modifications in order to incorporate this feature.

For example, *Qureshey* seems to suggest that there is only one “internet radio” for each base unit. Therefore, a base unit would not transmit on more than one radio frequency chosen by a user, unlike Applicant’s claimed invention which allows for transmissions on more than one preselected radio frequency. In addition, *Qureshey* suggests transmitting audio information obtained from a FM tuner 242 and AM tuner 240 in the base unit 900. Accordingly, if the base unit transmits FM radio broadcast information obtained from a FM tuner 242 over a FM radio channel chosen by a user, the FM tuner is likely to pick up the audio information transmitted over the chosen radio channel and not standard broadcast FM information that would normally be heard over a FM radio. Likewise, the situation would be the same for standard AM broadcasts to be transmitted over a chosen AM channel. Accordingly, there is no suggestion or motivation to make the proposed modification, since the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.” *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). In addition, *Qureshey* also specifically teaches that the preferred method of transmitting streaming audio information is “spread spectrum communication techniques” providing “a capability similar to that provided by a cordless telephone,” where these radio frequencies are not chosen by a user. Page 12-13, lines 31-5. Therefore, claim 1 is not obvious under the prior art of *Qureshey*, and the rejection should be withdrawn.

b. Claims 2-3, 6, & 9-10

Because independent claim 1 is allowable over the prior art of record, dependent claims 2-3, 6, and 9-10 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6, and 9-10 contain all the steps and features of independent claim 1. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

c. Claim 11

As provided in independent claim 11, Applicant claims:

11. An apparatus for receiving information and broadcasting the information in a localized area, the apparatus comprising:
means for receiving digital information from a remote source via the Internet;
means for converting the digital information to analog information;
and
means for broadcasting the analog information in a localized area in at least one preselected radio frequency chosen by a user.

(Emphasis added).

Applicant asserts that the rejection should be withdrawn because *Qureshey* fails to disclose or otherwise teach the step that is highlighted above. Specifically, *Qureshey* fails to disclose, suggest, or teach “means for broadcasting . . . in at least one preselected radio frequency chosen by a user,” as recited in claim 11. *Qureshey* appears to disclose an approach of providing a transmitted signal to a receiver using radio communication. However, *Qureshey* does not disclose, suggest, or teach the feature of the transmission occurring on a “preselected radio frequency chosen by a user.” Further, *Qureshey* does not provide the proper motivation to make modifications in order to incorporate this feature.

For example, *Qureshey* seems to suggest that there is only one “internet radio” for each base unit. Therefore, a base unit would not transmit on more than one radio frequency chosen by a user, unlike Applicant’s claimed invention which allows for transmissions on more than one preselected radio frequency. In addition, *Qureshey* suggests transmitting audio information obtained from a FM tuner 242 and AM tuner 240 in the base unit 900. Accordingly, if the base unit transmits FM radio broadcast information obtained from a FM tuner over a FM radio channel chosen by a user, the FM tuner is likely to pick up the audio information transmitted over the chosen radio channel and not standard broadcast FM information that would normally be heard over a FM radio. Likewise, the situation would be the same for standard AM broadcasts to be transmitted over a chosen AM channel. Accordingly, there is no suggestion or motivation to make the proposed modification, since the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.” *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Further, *Qureshey* also specifically teaches that the preferred method of transmitting streaming audio information is “spread spectrum communication techniques” providing “a capability similar to that provided by a cordless telephone,” where these radio frequencies are not chosen by a user. Page 12-13, lines 31-5. Therefore, claim 11 is not obvious under the prior art of *Qureshey*, and the rejection should be withdrawn.

d. Claim 13

Because independent claim 11 is allowable over the prior art of record, dependent claim 13 (which depends from independent claim 11) is allowable as a matter of law for at least the reason that dependent claim 13 contains all the elements and features of independent claim 11. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

e. Claim 17

As provided in independent claim 17, Applicant claims:

17. A method for receiving digital information and transmitting the information in a localized area, the method comprising the steps of:
receiving digital information from a remote source via the Internet;
converting the digital information to analog information;
broadcasting the analog information in a localized area in at least one preselected frequency modulated radio frequency chosen by a user.

(*Emphasis added*).

Applicant asserts that the rejection should be withdrawn because *Qureshey* fails to disclose or otherwise teach the step that is highlighted above. Specifically, *Qureshey* fails to disclose, suggest, or teach “broadcasting . . . in at least one preselected frequency modulated radio frequency chosen by a user,” as recited in claim 17. *Qureshey* appears to disclose an approach of providing a transmitted signal to a receiver using radio communication. However, *Qureshey* does not disclose, suggest, or teach the feature of the transmission occurring on a “preselected frequency modulated radio chosen by a user.” Further, *Qureshey* does not provide the proper motivation to make modifications in order to incorporate this feature.

For example, *Qureshey* seems to suggest that there is only one “internet radio” for each base unit. Therefore, a base unit would not transmit on more than one radio frequency chosen by a user, unlike Applicant’s claimed invention which allows for transmissions on more than one preselected radio frequency. In addition, *Qureshey* suggests transmitting audio information obtained from a FM tuner 242 and AM tuner 240 in the base unit 900. Accordingly, if the base unit transmits FM radio broadcast information obtained from a FM tuner over a FM radio channel chosen by a user, the FM tuner is likely to pick up the audio information transmitted over the chosen radio channel and not standard broadcast FM information that would normally be heard over a FM radio. Likewise, the situation would be the same for standard AM broadcasts to be transmitted over a chosen AM

channel. Accordingly, there is no suggestion or motivation to make the proposed modification, since the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.” *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). In addition, *Qureshey* also specifically teaches that the preferred method of transmitting streaming audio information is “spread spectrum communication techniques” providing “a capability similar to that provided by a cordless telephone,” where these radio frequencies are not chosen by a user. Page 12-13, lines 31-5. Therefore, claim 17 is not obvious under the prior art of *Qureshey*, and the rejection should be withdrawn.

f. Claims 18 & 21

Because independent claim 17 is allowable over the prior art of record, dependent claims 18 and 21 (which depend from independent claim 17) are allowable as a matter of law for at least the reason that dependent claims 18 and 21 contain all the features of independent claim 17. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

g. Claims 22-23

Because independent claim 1 is allowable over the prior art of record, dependent claims 22-23 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 22-23 contain all the features of independent claim 1. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

4. Response to Rejection of Claims 5, 7, 12, and 19 under 35 U.S.C. § 103(a)

Claims 5, 7, 12, and 19 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Qureshey* in view of *Lang* (U.S. Patent No. 5,737,692). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully traverses all rejections.

a. Claim 5

Because independent claim 1 is allowable over the prior art of record, dependent claim 5 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that the dependent claim 5 contains all the steps and features of independent claim 1. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claim 5 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

The feature “wherein the broadcasting of the analog information is initiated at a predetermined time chosen by the user and in said at least one predetermined frequency chosen by the user,” as recited in claim 5, is not disclosed, taught, or suggested by *Qureshey* in view of *Lang*. For example, *Lang* fails to suggest, disclose, or teach the features of a user selecting a time to initiate the broadcasting of analog information and also selecting the frequency that the transmission is to occur in. Hence, the prior art of *Qureshey* in view of *Lang* simply would not

result in Applicant's claimed invention, and the rejection should be withdrawn.

b. Claim 7

Because independent claim 1 is allowable over the prior art of record, dependent claim 7 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that dependent claim 7 contains all the steps and features of independent claim 1. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

c. Claim 12

Because independent claim 11 is allowable over the prior art of record, dependent claim 12 (which depends from independent claim 11) is allowable as a matter of law for at least the reason that dependent claim 12 contains all the elements and features of independent claim 11. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of independent claim 11, dependent claim 12 recites further features and/or combinations of features (as is apparent by examination of the claim itself) that are patentably distinct from the prior art of record.

d. Claim 19

Because independent claim 17 is allowable over the prior art of record, dependent claim 19 (which depends from independent claims 17) is allowable as a matter of law for at least the reason that dependent claim 19 contains all the features of independent claim 17. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

5. Response to Rejection of Claims 14-15 Under 35 U.S.C. § 103(a)

Claims 14-15 have been rejected under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Qureshey* in view of *Dao* (U.S. Patent No. 5,915,207). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. § 103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly, all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Because independent claim 11 is allowable over the prior art of record, dependent claims 14-15 (which depend from independent claim 11) are allowable as a matter of law for at least the reason that the dependent claims 14-15 contain all the elements and features of independent claim 11. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

6. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

For at least the foregoing reasons, all rejections and objections have been rendered moot, accommodated, and/or traversed, and Applicant respectfully request that all outstanding rejections be withdrawn and that all pending claims 1-7, 9-19, and 21-24 of this application be allowed to issue. If the Examiner has any comments regarding Applicant's response or intends to dispose of this matter in a manner other than a notice of allowance, Applicant requests that the Examiner telephone Applicant's undersigned agent.

Respectfully submitted,

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ANNOTATED VERSION OF MODIFIED CLAIMS TO SHOW CHANGES MADE

The following is a marked up version of the amended claims, wherein brackets denote deletions and underlining denotes additions.

1 5. (Once Amended) The method of claim 1, wherein the broadcasting of the analog
2 information is initiated at a predetermined time chosen by the user and in [a] said at least one
3 predetermined frequency chosen by the user.

1 24. (Once Amended) The apparatus of claim 12, wherein the program prompts the user
2 [sets] to specify the time [via the program] to activate the means for broadcasting.